

Applicant: Boulineau et al.
Serial No.: 10/680,658
Group Art Unit: 2873

PATENT
Docket No.: 10-9429

REMARKS

I. Introduction

This Amendment is filed in response to the Final Official Action dated June 20, 2005. In this Amendment, independent claims 1, 22, and 32 are being amended in accordance with discussions between the Examiner Stultz, Primary Examiner Schwartz, and David J. McKinley, Attorney for the Applicant, held on October 6, 2005 via telephonic interview. The Applicant thanks Examiner Stultz and Primary Examiner Schwartz for the interview. Following entry of this Amendment, Claims 1-34 and 37-45 remain pending for examination. As discussed during the telephonic interview, this Amendment is being filed with a Request for Continued Examination (RCE).

II. Drawings

The Examiner stated that Figure 1 should be designated by a legend such as "Prior Art." Accordingly, a replacement sheet is being submitted with Figure 1 so labeled.

III. Specification

The Examiner stated that the amendment to the specification filed in the response of April 5, 2005 corrected the previous objection, however, the amended paragraph should have replaced paragraph 14, rather than paragraph 13. The Applicant concurs and was referencing the published version of the application, which has different paragraph numbering than the application as filed. Hence, the Applicant has replaced paragraphs 13 and 14 herein with the correct paragraphs.

IV. Claim Rejections – 35 USC § 102

Claims 1-3, 5-7, 9, 11, and 13-14 are rejected under 35 USC § 102(b) as being anticipated by *Farwig*. During the telephonic interview of October 6, 2005, it was agreed that *Farwig* does not disclose an optical element for use in a mold for an injection molded lens comprising: a first layer having an outer side and an inner side, said first layer having a first size; a second, functional layer having a second size; said second, functional layer disposed adjacent said inner side of said first layer; and,

Applicant: Boulineau et al.
Serial No.: 10/680,658
Group Art Unit: 2873

PATENT
Docket No.: 10-9429

wherein said second size is smaller than said first size and smaller than an inner diameter of said mold. Hence, Claim 1 has been amended as such and is not anticipated by *Farwig*.

Support for the amended features is found in the Figures. Specifically, if one were to place the optical elements of either Figure 2 or Figure 3 in a mold, as shown in Figure 4, one would have an optical element that has a first layer with a first size and a second layer with a second size smaller than the inner diameter of the mold.

Because *Farwig* does not disclose an optical element for use in a mold for an injection molded lens, *Farwig* does not anticipate claims 1-3, 5-7, 9, 11, or 13-14. Thus, immediate withdrawal of these rejections is hereby requested.

IV. Claim Rejections – 35 USC § 103

Claims 4, 10, and 12 are rejected under 35 USC § 103(a) as being unpatentable over *Farwig* (Figure 4) in view of *Farwig* (Figure 2). As discussed above, and agreed upon during the telephonic interview of October 6, 2005, *Farwig* does not teach or suggest an optical element for use in a mold for an injection molded lens as recited by Claim 1 as amended. Claims 4, 10, and 12 depend from Claim 1. Thus, for at least this reason, Claims 4, 10 and 12 are not rendered obvious over of *Farwig* (Figure 4) in view of *Farwig* (Figure 2).

Claims 8, 15-21, 32-34, 37-39 and 41-45 are rejected under 35 USC § 103(a) as being unpatentable over *Farwig* (Figure 4) in view of *Robrahn et al.* However, as agreed upon during the telephonic interview of October 6, 2005, neither *Farwig* nor *Robrahn et al.* pertains to an optical element for use in a mold for an injection molded lens. Rather, *Farwig* and *Robrahn et al.* pertain to finished lenses. Hence, Claims 8 and 15-21, which depend from Claim 1, are patentable over *Farwig* and *Robrahn et al.*

Similarly, Claim 32 pertains to a functional wafer insertable into a mold for use in making an injection molded lens. Claims 33-34 depend from Claim 32. Neither *Farwig* nor *Robrahn et al.* pertain to a functional wafer insertable into a mold for use in making

Applicant: Boulineau et al.
Serial No.: 10/680,658
Group Art Unit: 2873

PATENT
Docket No.: 10-9429

an injection molded lens. Hence, Claims 32-34 are patentable over *Farwig* and *Robrahn et al.* for at least these reasons.

Previously present claims 37-39 and 41-45 pertain to a method of forming a lens having a functional layer including the steps of placing the wafer in a mold and injecting molten lens material into the mold to form a lens. As neither *Farwig* nor *Robrahn et al.* pertain to a method of forming a lens having a functional layer including the steps of placing the wafer in a mold and injecting molten lens material into the mold to form a lens, Claims 37-39 and 41-45 are patentable over *Farwig* and *Robrahn et al.*

Claims 22, 24 and 26-30 are rejected under 35 USC § 103(a) as being unpatentable over *Farwig* (Figure 3) in view of *Farwig* (Figure 4). In accordance with the telephonic interview of October 6, 2005, the Applicant has amended Claim 22 to clarify that the invention of Claim 22 is a method of making an optical element for use in a mold including the step of configuring the second layer function substance such that a size of the second layer functional substance is less than an inner diameter of the mold. It was agreed in this interview that *Farwig* does not teach or suggest a method of making an optical element for use in a mold. Hence, Claims 22, 24, and 26-30 are patentable over *Farwig* (Figure 3) in view of *Farwig* (Figure 4).

Claims 23, 25, and 31 are rejected under 35 USC § 103(a) as being unpatentable over *Farwig* (Figure 3) in view of *Farwig* (Figure 4) and further in view of *Robrahn et al.* However, Claims 23, 25 and 31 depend from Claim 22. During the telephonic interview of October 6, 2005, Claims 22 was deemed patentable over the prior art cited as none of the prior art cited teaches or suggests making an optical element for use in a mold. Hence, Claims 23, 25 and 31 are similarly patentable for at least this reason.

Applicant: Boulineau et al.
Serial No.: 10/680,658
Group Art Unit: 2873

PATENT
Docket No.: 10-9429

CONCLUSION

In view of the foregoing, it is submitted that upon entry of this Amendment, all pending claims 1-34 and 37-45 are now in condition for allowance. Hence, a Notice of Allowance is hereby requested.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: Oct. 20, 2005

David J. McKinley by Jh Llp
David J. McKinley, Esq.
Registration No. 42,867
Reg. 33,810

INSKEEP INTELLECTUAL PROPERTY GROUP, INC.
2281 W. 190th Street, Suite 200
Torrance, CA 90504
Telephone: (310) 755-7800
Facsimile: (310) 327-3466

Customer No. 37,374